

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jerry Doty, Luis A. Viriato and Ronald R. Meadows

Confirmation No: 7831

Serial No.: 09/753,307

Examiner: Karen L. Le

Filed: December 29, 2000

Group Art Unit: 2614

For: METHOD FOR SWITCHING ACTIVE CALLS

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

The Final Office Action does not comply with MPEP §§ 707.07(f) and 706.07

MPEP § 707.07(f) states “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” MPEP § 706.07 states “where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant’s reply.”

In the applicants’ response to the previous Office Action, dated October 15, 2007, the applicant traversed the rejections of claims 1-19 under 35 U.S.C. § 103(a) without amendment. The final Office Action, dated January 3, 2008, reiterates the same rejections, including errors (for instance, no specific portions of Chong or Denby are identified as teaching the features of claim 15), for claims 1-19 as those stated in the previous action. The final Office Action states that the “Applicant’s arguments filed 10/15/07 with respect to claims 1-19 have been fully considered but they are not persuasive.” See Final Office Action, page 6. However, the

Response to Arguments section of the Office Action does not address most of the applicant's arguments. For example, the Office Action states "Applicant mainly argues that Chong does not teach initializing a second processor while a current call is being processed on a first processor, and does not teach repeating the transfer of calls" and "Applicant further argues that Zech does not teach copying compression dictionary tables from a first entity into a second entity." *See* Office Action, page 7. These statements only address 3 out of the 14 arguments that applicant made in the prior response. Specifically, the applicant argued:

- Chong does not teach initializing a second processor while a current call is being processed on a first processor.
- Chong does not teach repeating the switching of calls from the first processor until the first processor is free for maintenance.
- Denby does not teach determining that a time has been reached for an upgrade of firmware on a first processor that is still actively handling calls.
- The Examiner is using impermissible hindsight in combining Denby with Chong.
- Chong teaches away from the proposed combination with Denby.
- Chong does not teach releasing the first processor from further processing of the call.
- Chong does not teach processors being located within the same module, in different modules on the same card, and on different cards in the network device.
- Chong does not teach initiating a retrain sequence on the second processor.
- Chong does not teach that information about a current call includes modulation.
- Chong does not teach a computer readable medium comprising a downloadable file.
- Chong does not teach a computer readable medium comprising an image file uploadable into a digital signal processor.
- The distributed database in Chong is not equivalent to the recited network device.
- Zech does not teach copying compression dictionary tables from the first entity; and loading compression tables in a second entity.
- Zech does not teach information about a current call that is active on a processor including a country code.

Because the Final Office Action only addresses a small fraction of the applicant's arguments for patentability, the Final Office Action does not comply with MPEP §§ 707.07(f) and 706.07.

The Office Action has not Established Prima Facie Obviousness

With reference to the combination of Chong and Denby, the Office Action merely states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teach [sic] of Denby into Chong’s system in order to determine that an upgrade time has arrived.” In other words, the Office Action merely states that a first reference teaches one part of the claimed invention and a second reference teaches another, and therefore it is obvious to combine them. However, this bald assertion does not establish *prima facie* obviousness. MPEP § 2141(III) states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 550 U.S. at ___, 82 USPQ2d at 1396.

The MPEP goes on to provide several exemplary rationales to support an obviousness rejection. The Office Action does not provide any supporting rationale for the rejection other than the fact that the references purportedly teach elements of the claims. Therefore, the Office Action has not established *prima facie* obviousness for the combination of Chong and Denby. The same argument applies to the obviousness rejection of claim 5 under Chong, Denby, and Zeck.

With respect to the rejection of claim 8 under Chong, Denby, and Zeck, the Office Action again fails to establish *prima facie* obviousness. The Office Action does not provide any basis for the assertion that information about a current call including a country code is taught in any of Chong, Denby, or Zeck. Therefore, *prima facie* obviousness is not established because all of the features of the claim are not taught in the references.

The Combination of Chong and Denby is Improper

The combination of Chong and Denby in the Office Action is improper because Chong teaches away from the proposed combination and the Examiner is relying upon impermissible hindsight. MPEP § 2141.03(VI) states “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Chong specifically teaches that its invention addresses the problem in the prior art that “new technology

is needed to reduce the effects of the failures [of call processors] between the updates” (*see* Chong col. 1, lines 29-32, *emphasis added*). Therefore, Chong specifically teaches that the failures it is referring to are not analogous to reaching a time for a firmware upgrade; they happen *between* upgrades. Consequently, Chong teaches away from a combination that would replace its ‘failure determination’ with a determination that a time has been reached for a firmware upgrade, as the Office Action proposes.

Also, the Examiner is using impermissible hindsight in combining Denby with Chong. MPEP § 2142 states “impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art.” The Examiner proposes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teach [sic] of Denby into Chong’s system in order to determine that an upgrade time has arrived. When the detection method in Chong is applied earlier (apply before the processor is failed) then all calls that are transferred will also include all active calls at the time the second server is being initialized.” *See* Office Action page 3. Everything that the Examiner is pointing to as justifying the combination comes from the applicant’s own disclosure and is therefore impermissible hindsight. There is no suggestion in Chong to apply its redundant call system to determine upgrade times; the entire disclosure of Chong is directed to managing a call when a server fails. Denby has nothing to do with call processing and thus could not provide the rationale that the Examiner is proposing. In essence, the Examiner has read the applicant’s disclosure, seen all the inventive principles relating to preventative upgrades embodied therein, and then found those principles obvious in view of a patent that deals specifically with handling device failures and has nothing to do with preventative maintenance. This is the very definition of impermissible hindsight. Therefore, the applicant submits that the combination of Denby with Chong is improper.

The Combination of Chong and Denby Does Not Teach the Features of the Claims

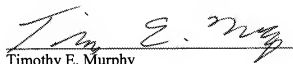
As mentioned above and more fully described in the applicant’s response dated 3 March 2008, the combinations proposed by the Examiner do not teach the majority of the claimed features. The applicant has twice provided to the Examiner detailed explanations of how the claimed features are not taught in the references. In response, the Examiner has repeatedly provided cursory assertions essentially saying the applicant is wrong, but not provided any

concrete evidence to refute the applicant's arguments. The Advisory Action dated 31 March 2008 is a further example of this, in which the Examiner simply states that the references teach the claimed features, but does not provide any evidence to back up these statements. The Examiner's failure to provide supporting rationales for the rejections has unreasonably extended the prosecution of this application and denied the applicant a fair opportunity to get this application allowed.

For each of the reasons identified above, the applicant requests that the Pre-Appeal Panel reverse the Examiner's rejections and allow the applicant's claims.

Respectfully submitted,

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